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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/612,659

07/02/2003

Delma S. Hume

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7590

09/22/2008

Caterpillar Inc.
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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3687

MAIL DATE

DELIVERY MODE

09/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/612,659	Applicant(s) HUME ET AL.	
	Examiner VANEL FRENEL	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20030915, 20040223</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the election filed on 8/15/08. Claims 15-19 have been elected. Claims 15-19 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

Claim 15 recites the limitations of: "the time of sale" in line 4; "the amount of credit available for returning" in line 8 and "the oldest available liability" in line 10. There are insufficient antecedent basis for these limitations in the claim. Appropriate correction is needed.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 15-19 are rejected under 35 U.S.C.101 because the claimed invention is directed to non-statutory subject matter.

Claim 15 recite a process comprising the steps of: having a plurality of remanufacturer liabilities, receiving a core, inspecting a core, determining the amount of credit, selecting, applying, purchasing and remanufacturing. Based on Supreme Court

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precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Junger (6,463,421) in view of Hauser et al. (6,536,659).

(A) As per claim 15, Junger discloses a method for remanufacturing cores into remanufactured items, comprising the steps of: having a plurality of remanufacturer liabilities associated with different deposits paid to secure return of cores at the time of sale of remanufactured items (See Junger, Col.3, lines 33-65 to Col.4, line 14);

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receiving a core (See Col.8, lines 53-65); inspecting the core (See Junger, Col.7, lines 26-67).

Junger does explicitly disclose determining the amount of credit available for returning the core based upon the inspection; selecting the oldest available liability against which to apply the credit irrespective of the deposit paid on sale of the item associated with the return of the core; applying the credit against the selected liability to purchase the core; purchasing the core based upon applying the core credit; and remanufacturing the core.

However, these features are known in the art, as evidenced by Hauser. In particular, Hauser suggests that the method having determining the amount of credit available for returning the core based upon the inspection (See Hauser, Col.2, lines 39-67); selecting the oldest available liability against which to apply the credit irrespective of the deposit paid on sale of the item associated with the return of the core (See Hauser, Col.5, lines 5-35); applying the credit against the selected liability to purchase the core (See Hauser, Col.5, lines 5-35); purchasing the core based upon applying the core credit (See Hauser, Col.5, lines 13-20); and remanufacturing the core (See Hauser, Col.5, lines 58-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Hauser within the system of Junger with the motivation of providing a method which defined for handling returned merchandise on behalf of a plurality of different merchants (See Hauser, Col.2, lines 10-12).

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(B) As per claim 16, Junger discloses the method wherein the step of determining core credit is from a choice of one of full, partial and zero credit (See Junger, Col.9, lines 1-7).

(C) As per claim 17, Junger discloses the method further including the steps of: establishing an entitlement in the amount of each deposit paid to secure return of a core and having a date identifier (See Junger, Col.8, lines 33-67); and canceling the entitlement after return of core where the entitlement is the oldest available entitlement associated with the returned core (See Junger, Col.8, lines 33-67); and wherein the step of selecting the liability is based upon an association of the liability and the entitlement (See Junger, Col.8, lines 42-65).

(D) As per claim 18, Junger discloses the method wherein the step of selecting the oldest available liability includes selecting from liabilities that have not been available beyond a certain attrition date (See Junger, Col.8, lines 33-60).

(E) As per claim 19, Junger discloses the method wherein the step of applying the credit against the selected liability includes applying full credit against the selected liability where the core was received within a first time period ending prior to the attrition date and applying less than full credit where the core was received within a second time period of the attrition period (See Junger, Col.8, lines 33-65).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanel Frenel/

Examiner, Art Unit 3687

September 13, 2008